

11-14-05

AFB



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 1545)

Application of:

Moll et al.

Serial No.: 09/826,139

Filed: April 4, 2001

For: Method and System For Providing
Location Based Information To A
Mobile Station

Group Art Unit 2687

Examiner: Un C. Cho

Confirmation No. 2337

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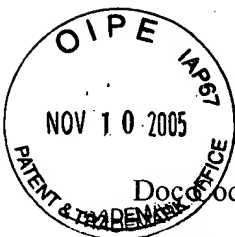
Sir:

TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached:
 - a. Notice of Appeal;
 - b. Pre-Appeal Brief Request for Review;
 - c. Reasons for Review (4 pages); and
 - d. Return Receipt Postcard.
2. With respect to additional fees, please charge \$500.00 to Deposit Account No. 210765 to cover the fee for the Notice of Appeal.
3. Please charge any additional fees or credit overpayment to Deposit Account No. 210765. A duplicate copy of this sheet is enclosed.
4. CERTIFICATE OF MAILING UNDER 37 CFR § 1.10: The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as Express Mail receipt number EV333556338 US, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 10th day of November, 2005.

By: Richard A. Machonkin
Richard A. Machonkin
Reg. No. 41,962



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1545

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Typed or printed name _____

Application Number

09/826,139

Filed

April 4, 2001

First Named Inventor

Keith E. Moll

Art Unit

2687

Examiner

Un C. Cho

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 41,962☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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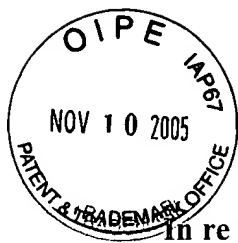
November 10, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 1545)

In re the Application of:

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Moll et al.)	Art Unit: 2687
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Serial No.: 09/826,139)	
)	
Filed: April 4, 2001)	Examiner: Un C. Cho
)	
For: Method and System For Providing)	Confirmation No. 2337
Location Based Information To A)	
Mobile Station)	

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Alexandria, Virginia 22313-1450

REASONS FOR REVIEW OF FINAL REJECTION

Applicants request review of the final rejection mailed August 10, 2005, because the Examiner has clearly erred in rejecting the pending claims as being obvious under § 103(a).

1. The Claimed Invention

Applicants' claims are directed to methods and systems for providing location based information to a mobile station in communication with a cellular wireless system. The claimed methods and systems make use of a *service identifier* that is included in a request for location based information regarding a service. In particular, each of the independent claims, i.e., claims 4, 9, 12, and 13, recites, in one way or another, the functions of (i) receiving a request for location based information regarding a service, wherein the request includes a *service identifier*

that is associated with the service, (ii) associating a level of granularity with the *service identifier*, and (iii) based on the *service identifier*, instructing the cellular wireless system to determine the position of the mobile station at the associated level of granularity.

2. Status of the Claims

Claims 2-15 are currently pending. All claims stand rejected under § 103(a) as being obvious over various combinations of references. In each of the combinations, the Examiner relies on Papadimitriou et al., U.S. Patent No. 6,385,458 (“Papadimitriou”) for elements (ii) and (iii) cited above.

3. The Examiner’s Clear Error

There are two aspects of the Examiner’s clear error. In a first aspect, the Examiner’s argument for why Papadimitriou discloses elements (ii) and (iii) is internally inconsistent. In a second aspect, even if Papadimitriou could be viewed as disclosing both elements (ii) and (iii), the resulting combination would not include element (i). These two aspects of the Examiner’s clear error are discussed separately below.

a. The Examiner’s Argument Is Internally Inconsistent

For element (ii), the function of associating a level of granularity with the service identifier, the Examiner has identified the “location request” in Papadimitriou as the “service identifier.” For example, in rejecting claim 4, the Examiner argued: “Papadimitriou discloses associating a level of granularity (precision) with the service identifier (location request)” (Office Action mailed August 10, 2005, page 3).

For element (iii), the function of based on the service identifier, instructing the cellular wireless system to determine the position of the mobile station at the associated level of granularity, the Examiner has identified the “priority information” in Papadimitriou as the

“service identifier.” In particular, for element (iii), the Examiner cited to a section of Papadimitriou that makes clear that the location of the mobile terminal is estimated to a precision that is based on the priority information:

[T]he LMUs servicing the terminal device use the priority information generated in the GMLC location estimate request step 235 to estimate the location of the terminal device to a predetermined precision in a location estimate step 245.

(col. 6, lines 41-45).

This “priority information” that the Examiner uses as the “service identifier” for element (iii) is not the “location request” that the Examiner uses as the “service identifier” for element (ii). Indeed, Papadimitriou makes clear that the “priority information” is obtained *after* the “location request.” As shown in Figure 2 of Papadimitriou, the user makes the “location request” in step 215 (col. 5, lines 56-58). Then, the user is prompted to enter a desired priority level in step 220 (col. 5, line 66 – col. 6, line 2). The desired priority level is checked against the subscribed priority level in step 225. If the subscribed priority level is not exceeded, the process goes through steps 235, 240, and 245 to estimate the location of the terminal device to a precision that is based on the priority level (col. 6, lines 3-45).

Because the Examiner relies on Papadimitriou’s “location request” as the “service identifier” in element (ii), but relies on Papadimitriou’s “priority information” as the “service identifier” in element (iii), the Examiner’s argument that Papadimitriou discloses both elements (ii) and (ii) is internally inconsistent and, therefore, clearly erroneous.

b. The Examiner’s Prior Art Combinations Would Not Include Element (i)

Even if Papadimitriou could be viewed as disclosing both elements (ii) and (iii), combining Papadimitriou with the other references would not result in element (i), the function

of receiving a request for location based information regarding a service, wherein the request *includes* a service identifier that is associated with the service.

This is because Papadimitriou discloses using “priority information” that is obtained *after* the user’s location request to determine the precision of the location estimate, as described above.

Thus, if Papadimitriou were to be combined with the other cited art, the result would not be a method in which the service identifier is *included* in the location request. At best, the result would be a method in which the user makes a request for location based information regarding a service and is *subsequently* prompted to enter a desired priority level on which the level of granularity for the position determination is based.

Indeed, by emphasizing that the user is prompted to enter a desired priority level after making the location request (col. 5, line 66 – col. 6, line 2), Papadimitriou actually teaches away from the element (i) approach in which the service identifier that determines the level of granularity is *included* in the location request.

Because the Examiner’s asserted combinations based on Papadimitriou would not include element (i), the Examiner’s claim rejections are clearly erroneous.

4. Conclusion

For the foregoing reasons, Applicants submit that all of the pending claims should be allowed.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: November 10, 2005

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